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EXAMINER

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 12

Application Number: 09/903,500

Filing Date: July 12, 2001

Appellant(s): John ECKL

Michael J. Cummings

For Appellant

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EXAMINER'S ANSWER

This is in response to the appeal brief filed January 30, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

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(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The appellant statement that all claims stand or fall together is correct.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

5,802,498	COMESANAS	9-1998
5,699,528	HOGAN	12-1997

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

(a) Claims 12, 14, 15, 17-23, 25-27, 29-34, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Comesanas (5,802,498).

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Claims 12 and 18: Comesanas discloses an automated billing system and method comprising:

- a. A billing server to receive billing information (col 2, lines 55-66);
- b. A routing means for processing/routing the information to a printer or to the electronic information server (col 3, lines 4-24 and col 4, lines 50-53);

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- c. A printer connected to the server (col 3, lines 4-24 and col 4, lines 50-53);
- d. An electronic information server to convert the billing information for electronic transmission and to transfer the electronic billing statement to the customer (col 3, lines 4-24 and col 4, lines 50-53); and
- e. A lookup table containing delivery preferences for at least one customer.

While Comesanas does not explicitly disclose that the delivery preferences of the customer(s) are maintained in a lookup table, it is inferred that this information is being stored in some type of data file. Since Comesanas explicitly discloses that the system will “determine whether each of the debtors has signed an agreement to pay transmittal charges (col 4, lines 44-46)(for electronic transmission) and will determine “whether each of said invoices is to be sent electronically or by mail” (col 4, lines 50-52), it is inherent that the system must look up both preferences, using one of the standard “lookup” devices in the database arts such as lookup tables.

Comesanas also does not explicitly disclose converting the billing information to the proper format for printing or for electronically transmission; however, Official Notice is taken that it is old and well known within the communications art to convert data to the appropriate format for transmission, such as HTML for electronic transmissions and the appropriate print file type for the system printer. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the data in Comesanas’ system was being converted to the proper format for printing or electronic transmission.

Claim 14: Comesanas discloses an automated billing system and method as described in Claim 12 above, and further discloses the billing server containing billing information about a plurality of recipient

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(customers) which separates the billing information corresponding to individual recipients (col 3, lines 35-39).

Claim 15: Comesanas discloses an automated billing system and method as in Claim 12 above and further discloses an inserter (collation) connected to the printer (col 3, lines 35-39).

Claims 17 and 20: Comesanas discloses an automated billing system and method as described in Claims 12 and 18 above and further discloses a means to transmit funds to the biller (col 3, lines 13-24).

Claim 19: Comesanas discloses an automated billing system and method as described in Claim 18 above and further discloses the customer completing a written agreement delineating the customer's preferences on the type of billing, the charges authorized to be collected, etc. (col 3, lines 4-24) and storing them in a database. However, Comesanas does not explicitly disclose that the customers' preferences are stored as a lookup table in the database. Official notice is taken that it is old and well known within the database art to place use a table format to save memory space when storing such data. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a table to store the customer's selection of delivery means. One would have been motivated to use a lookup table in order to minimize the amount of memory required to store the information for a large number of customers. By placing the data in a table, each customer's file could have a one-bit identifier for the type of delivery instead of a much larger field to store the delivery instructions.

Claims 21, 26, 30, and 32: Comesanas discloses an automated billing system, apparatus, and method comprising:

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- a. Accessing billing information comprising a plurality of records (col 2, lines 55-66) corresponding to one recipient;
- b. Isolating each record from the billing information (col 2, lines 55-66);
- c. Extracting delivery preference information from the database for each record (col 3, lines 17-24 and col 4, lines 50-52);
- d. Determining whether each record is intended for printed or electronic transmission based on delivery preference information (col 3, lines 17-24 and col 4, lines 50-52);
- e. Converting the billing information for electronic transmission and transmitting the electronic billing statement to the customer (col 3, lines 4-24 and col 4, lines 50-53);
- f. Routing the billing information to a printer or to the electronic information server (col 3, lines 4-24 and col 4, lines 50-53);

Comesanas does not explicitly disclose converting the billing information to the proper format for printing or for electronically transmission; however, Official Notice is taken that it is old and well known within the communications art to convert data to the appropriate format for transmission, such as HTML for electronic transmissions and the appropriate print file type for the system printer. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the data in Comesanas' system was being converted to the proper format for printing or electronic transmission.

Comesanas also does not disclose the feature in Claim 30 wherein the switch routes all of the record to the printer if the server fails or is taken out of service. Official Notice is taken that it is old and well known with the communications art to redirect output to another format/device when part of the network fails or is otherwise not available. In this instance, it would have been obvious to one having

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ordinary skill in the art at the time of invention was made to redirect the electronic bills in the Comesanas invention to the printer and to then transmit the bills through the normal postal channels. One would have been motivated to do so in order to facilitate timely transmission of the bills and receipt of payments, thus decreasing the financial loss to the crediting organization and to the customer (through the levying of “late charges”).

Finally, while Comesanas discloses retrieving the customer’s billing preference from a database, it is not explicitly disclosed whether this is the same database that contains the billing data or a separate database. Official Notice is taken that it is old and well known within the database arts that data may be stored in one, two, or more databases and then combined as needed. This is referred to as a multidatabase (MDBS) system and has been in use for many years. One of the main advantages of an MDBS is its ability to “access data from a variety of preexisting” (legacy) “databases located in various heterogeneous hardware and software environments.” (Korth and Silberschatz, “Database System Concepts”, 1991, page 518). It is also common for businesses to store transaction information (billing data) in one file or database and to store customer data (such as name, address, phone, billing and payment preferences, etc.) in a different file or database, and then extract the needed data when compiling bills, reports, etc. The two main reasons that this data is kept separate is: (1) to decrease the required storage space by eliminating storing duplicate information, such as the customer’s name and address, with each transaction completed during the billing period; and (2) to facilitate updating the customer’s data, such as address, by eliminating the need to search for and replace every instance of the data if duplicate data is maintained as in (1) above. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to maintain the customer data in the

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Comesanas invention in a database separate from the billing data. One would have been motivated to maintain separate databases for the reasons discussed above.

Claims 22 and 27: Comesanas discloses an automated billing system and method as described in Claims 21 and 26 above and further discloses the customer completing a written agreement delineating the customer's preferences on the type of billing, the charges authorized to be collected, etc. (col 3, lines 4-24) and storing them in a database.

Claims 23 and 34: Comesanas discloses an automated billing system and method as in Claim 21 and 30 above and further discloses an inserter (collation) connected to the printer (col 3, lines 35-39).

Claims 25, 29, and 36: Comesanas discloses an automated billing system and method as described in Claims 21, 26, and 30 above and further discloses a means to electronically transmit funds to the biller (col 3, lines 13-24).

Claim 31: Comesanas discloses an automated billing system and method as described in Claim 30 above, and further discloses the billing server containing billing information about a plurality of recipient (customers) which separates the billing information corresponding to individual recipients (col 3, lines 35-39).

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Claim 33: Comesanas discloses an automated billing system and method as described in Claim 31 above, but does not disclose that each record is sanitized. Examiner notes that Applicant has defined “sanitized” in the specification (page 3, lines 24-27) as a filter “which performs a number of convenient functions, such as verifying and/or correcting the accuracy of a customer’s address, etc.”. Official Notice is taken that it is old and well known within the accounting and database arts to verify and correct data such as addresses, phone numbers, etc. in order to maintain the most up-to-date database as possible. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a means to verify and correct the information within the databases in Comesanas. One would have been motivated to verify and update the information to ensure that the bills are directed to the correct address, thus precluding the wasteful expenditure of time and funds.

(b) Claims 16, 24, 28, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Comesanas (5,802,498) in view of Hogan (5,699,528).

Claim 16: Comesanas discloses an automated billing system as in Claim 12 above, but does not disclose determining whether or not the recipient has received and viewed the information. Hogan discloses a similar automated billing system and method in which the server determines whether or not the recipient has reviewed the information (col 10, lines 13-21). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include such a determination method in Comesanas’ electronic billing processor. One would have been motivated to include a determination method in order to verify the customer had received and opened the electronic bill and to

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ensure the correctness of the information within the database. Non-receipt and/or non-viewing of the bill could indicate the need to update of the information.

Claims 24, 28, and 35: Comesanas discloses an automated billing system as in Claim 21, 26, and 30 above, but does not disclose determining whether or not the recipient has received and viewed the information. Hogan discloses a similar automated billing system and method in which the server determines whether or not the recipient has reviewed the information (col 10, lines 13-21). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include such a determination method in Comesanas' electronic billing processor. One would have been motivated to include a determination method in order to verify the customer had received and opened the electronic bill and to ensure the correctness of the information within the database. Non-receipt and/or non-viewing of the bill could indicate the need to update of the information.

(11) Response to Argument

A. Rejections based solely on Comesanas

The Appellant argues that Comesanas "fails to satisfy the "delivery preference" elements recited in the rejected independent claims because it has nothing to do with a delivery preference for electronic or printed delivery" (page 6). The Appellant admits that Comesanas "identifies both mail and electronic transmittal as potential means of delivery for invoices" (page 6) and cites a passage from column 3 of the reference to show that "electronic transmittal being an alternative to paper mail transmittal, there is no description or indication that invoice recipients have an opportunity to express preferences of whether to receive bills by electronic or printed transmission" (page 7). The Examiner notes that, as the Appellant

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points out, Claims 3 and 4 of Comesana expressly discloses a system in which the invoices are sent either by electronic or printed transmission. The system determines (by a “look up table”, i.e. database) “whether the debtor “has signed an agreement to pay transmittal charges for return payment” (col 4, lines 45-46) or whether the debtor “has signed an agreement to pay transmittal charges for return payment by mail” (col 4, lines 59-60). The system also determines “whether each of said invoices is to be sent electronically or by mail” (col 4, lines 50-52). Claim 4 of Comesana clarifies even further that the debtors have indicated their transmittal preferences by showing that the electronic transmittal charges are added to the “invoices generated for each of said selected debtors who had signed such an agreement”. Since the system must determine which invoices to send electronically and which invoices to send through the postal mail, and since the system decides this by looking in the database to see which debtors have authorized the system to charge a transmittal fee for the corresponding method of transmittal, the Examiner considers the authorization received from the debtor to be an indication of the transmittal preference of that debtor.

B. Rejections Based on Comesanas in View of Hogan

The Appellant argues that Hogan does not include the feature of the selection of printed or electronic transmittal based on prescribed customer preferences. The Examiner agrees that Hogan was not cited to disclose this feature; however, as discussed above, this feature is already disclosed in Comesanas. Therefore, the Appellant’s argument in reference to Hogan is moot.

The Examiner also notes that the Appellant has not argued any of the Official Notices taken in the rejection of the claims; and, therefore, it is implied that the Appellant concedes that these features are well known within the art.

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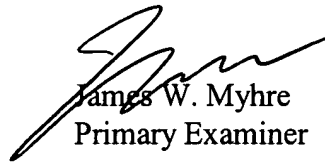
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



jwm


February 26, 2003




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